

**REMARKS**

**35 USC 101**

Claims 23-25 and 27-31 are rejected under 35 USC 101 for being directed to non-statutory matter. Applicants amend independent claim 23 to recite that the messaging server comprises a machine-readable data storage medium. Support for this amendment can be found, for example, on page 9 of the specification. Applicants believe that the amended claims recite statutory subject matter and request that the Examiner withdraw the rejection.

**35 USC 103(a)**

Claims 7-9, 11-25, and 27-31 are rejected under 35 USC 103(a) as being unpatentable over Schoen et al. (US Pub. No. 2003/0204720) in view of Perlman et al. (US Pat. No. 5,261,002). Applicants respectfully traverse the rejection.

To establish a prima facie case of obviousness of a claimed invention, all the claimed features must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The Examiner has failed to establish a prima facie case that either Schoen or Perlman discloses a messaging server that removes the digital certificate from the publication record, identifies other logged-in subscriber devices that previously designated the particular subscriber device for potential future secured instant messaging, and notifying the identified devices of the digital certificate withdrawn from use, as recited by, e.g., claim 7.

**Request to Unpublish**

Claim 7 recites a method of managing the exchange of secure online instant messages between subscriber devices comprising receiving a subscriber device's request to unpublish its digital certificate. The Examiner concedes that Schoen does not expressly disclose this feature. The Examiner maintains, however, that this feature is disclosed in Perlman.

Perlman does not disclose un-publishing digital certificates. Perlman discusses a blacklist, which contains an entry for every unexpired certificate that should be considered invalid. Column 6, lines 39-40. If a user wants to verify the authenticity of

another user, he can request a copy of the other user's certificate and a copy of the blacklist to determine if the issue date of the certificate is prior to the blacklist start date and therefore invalid. See column 7, lines 45-58. Thus, the user's certificate cannot be unpublished, because the user can request it.

Perlman discusses a technique for revoking user certificates of authenticity by renewing certificates, which revokes the certificates they replace. Abstract, column 4, lines 59-60. This is the only reference in the patent to revoking a user certificate. This is not the same as a request to un-publish the certificate because in Perlman, a certificate is still associated with the user. Only the outdated version of the certificate is removed, not the certificate itself.

Furthermore, claim 7 recites receiving a particular subscriber *device's* request to un-publish its digital certificate. In Perlman, the Certification Authority issues certificates and published blacklists and a *user* verifies the authenticity of another user. Column 6, lines 18-19, 38-39, 41-46. Thus, Perlman does not disclose a subscriber device at all, let alone a subscriber device's request to un-publish its digital certificate.

#### **Identifying Other Logged-in Subscriber Devices**

Perlman does not teach or suggest a messaging server performing the step of identifying other logged-in subscriber devices that previously designated the particular subscriber device for potential future secured instant messaging. Perlman does not discuss subscriber devices, nor the distinction between logged-in and logged-out devices. Furthermore, as mentioned above, it is not a messaging server but rather a user that authenticates other users in Perlman. Column 7, lines 47-49.

#### **Withdrawn from Use**

Claim 7 recites a messaging server performing the step of notifying identified devices of the digital certificate withdrawn from use. Perlman does not teach or suggest notifying devices that a digital certificate was withdrawn from use. The Examiner equates "revoking" with "withdraw" as recited in Claim 7: "digital certificate withdrawn from use." The term revoking is used in Perlman once in the abstract in the context of a technique for revoking user certificates and another time at column 4, lines 59-60 to describe

renewing a certificate, which revokes the old certificate. Thus, only a version of the digital certificate is revoked.

Furthermore, Perlman does not teach or suggest a messaging server notifying identified devices of the digital certificate withdrawn from use, as Perlman does not even disclose the step of notification. If a user wants to verify the authenticity of another user's public key, the user checks for a certificate and a blacklist.

In conclusion, the combination of Schoen and Perlman fails to teach each and every element of claim 7. The Examiner points out that one cannot show nonobviousness by attacking references individually where the rejections are based on a combination of references. Applicants, however, are merely requesting that the Examiner satisfy the burden of proving a prima facie case of obviousness. Where neither cited reference, alone or in combination, discloses recited limitations, this burden has not been met.

#### **Teaching, Suggestion, or Motivation to Combine**

As will be appreciated, in light of both the recent decision by the United States Supreme Court in the case of *KSR International Co. v. Teleflex, Inc. et al.*, (decided April 30, 2007), and, the recent Memorandum to all Technology Center Directors from Deputy Commissioner for Patent Operations, Ms. Margaret A. Focarino (regarding interim "points" for obviousness determinations), the assessment of non-obviousness has been reaffirmed to rely on the Graham factors, with the test of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter still providing a helpful insight in determining whether claimed subject matter is non-obvious under 35 U.S.C. §103(a).

Even if Schoen and Perlman contained all of the limitations of claim 7, there is no teaching, suggestion, or motivation to combine these references.

Schoen concerns a method and apparatus for facilitating instant messaging that uses a public key infrastructure (PKI) proxy to manage the secure exchange of instant messages. [0029], [0032] Specifically, the proxy helps to insure that the information is not disclosed to unauthorized parties and assures that the identities of all participants are known and trusted. [0032]

Perlman concerns a system where a *user* verifies the identify of another user by determining if there is an unexpired certificate for the other user, and then checks a blacklist to determine whether the other user's certificate has been invalidated. Column 6, lines 41-46.

There is no motivation to combine the references for several reasons. Everything in Schoen is accomplished by using dedicated instant messaging servers. [0002] A person of ordinary skill in the art would not combine Schoen with the authenticating method disclosed in Perlman because it requires a *user* to perform the authenticating steps. The combination would require too much time and effort on the user's part and would result in an unreliable system subject to human error.

In addition, a person of ordinary skill in the art would not combine Schoen with Perlman because Schoen provides for the secure exchange of instant messaging through the use of a PKI proxy. Thus, Schoen does not present a problem that can be solved by combining it with Perlman.

Because claims 8, 9, and 11-22 depend upon claim 10, they are patentable for at least the same reasons. Independent claim 23 is substantially similar to claim 7 and therefore patentable for at least the same reasons. Because claims 24, 25, and 27-31 depend upon claim 23, they are patentable for at least the same reasons.

#### **Conclusion**

Applicants respectfully posit that the pending claims have been distinguished from the art of record, and that the rejection of the claims has been overcome. Accordingly, Applicants respectfully request allowance of all claims. The Examiner is invited to please contact Applicants' attorney at (650) 474-8400 should any questions arise.

Respectfully submitted,

  
Elizabeth Ruzich

Reg. No. 54,416

Customer No. 22,862